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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,548	01/09/2002	Peng Chum Loh	5196-000003	4658

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EXAMINER

WESSMAN, ANDREW E

ART UNIT	PAPER NUMBER
1742	G

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

M/9

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/890,548	LOH, PENG CHUM
	<b>Examiner</b>	<b>Art Unit</b>
	Andrew E Wessman	1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 September 2002.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-11 and 13-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-11 and 13-15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

### **DETAILED ACTION**

1. Claims 1-11 and 13-15 remain for examination. Claim 12 has been cancelled.
2. In light of the amendment filed September 3, 2002, the rejections under 35 U.S.C. 112, 2<sup>nd</sup> paragraph have been withdrawn.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 59093847 A.

JP '847 is applied to the claims for the reasons set forth in paper No. 7 paragraph

- 5.

5. Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP '847 and JP '729.

JP '847 and JP '729 are applied to the claims for the reasons set forth in paper No. 7, paragraph 7.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 5-9 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '729.

JP '729 is applied to the claims for the reasons set forth in paper No. 7, paragraph 9.

With regards to the amended features of claim 7, the claim has been amended to clarify the claim, and the scope of the claim has not been affected.

With regards to the amended features of claims 5 and 13, the claims have been amended to recite that the alloy contains at least some amount of nickel and/or palladium, up to a total of 4 wt% palladium and 2 wt% nickel. This is not sufficient to patentably distinguish the alloys of the claimed invention from the alloys of the prior art. JP '729 teaches that the alloy may contain 7 wt% or more of additions of nickel and palladium to the alloy. A prima facie case of obviousness exists where the claimed ranges do not overlap but are close enough that but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). In this case, the maximum additions of applicant's claimed invention, 6 wt%, would have approximately the same properties as the lower end of the prior art disclosure, 7 wt% of additions. The burden is on the applicant to show that the alloys of the claimed invention having 6 wt% of nickel and palladium additions have materially different properties from the prior art alloys having 7 wt% additions of nickel and palladium. Applicant has also claimed as a low end of the range simply the necessity that either nickel or palladium be present in the alloy, and in order to differentiate the alloys of the claimed invention from those of

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the prior art of JP '729 and/or JP '847, applicant must also show that the addition of trace amounts of the elements to the alloys produces a materially different alloy than would be present without the elemental additions (compare 0.001 wt% to 0 wt%). Without a showing that the claimed invention is materially different than the prior art alloys, the alloys are considered to be substantially the same. Furthermore, applicant's use of the open language "comprising" does not preclude the addition of further elements, which could include the cobalt addition of JP '729 in amounts that would result in the claimed invention being substantially the same as the prior art.

*Response to Arguments*

8. Applicant's arguments filed September 3, 2002 have been fully considered but they are not persuasive. In the remarks, applicant argues:

- (1) The alloys of JP '847 do not necessarily possess the claimed amount of gold;
- (2) The broad range of the prior art does not necessarily anticipate the narrow range of the claimed invention; and
- (3) The additions of nickel and palladium to the alloys of the claimed invention are in different amounts than in the prior art.

With regards to applicant's argument (1), the alloys of JP '847 are directed towards binary Au-Al alloys of 15-30 wt% aluminum and gold, with no mention of any other additional elements. While not specifically mentioning the gold content in mass percent, with no mention of other elements it is assumed the remainder is gold, in which case the gold content is 70-85 wt%. Applicant's argument is specious as there is no reason to assume other elements are present, especially in light of the specific

mention in JP '847 that the alloy is purple in color and used in the same field of endeavor as applicant's alloy, jewelry.

With regards to applicant's argument (2), while it is true that a genus does not necessarily anticipate a species, applicant's claimed range of 16.5-21.5 wt% aluminum, balance gold encompasses a substantial portion of the prior art range of 15-30 wt% aluminum, and so applicant must provide evidence that the upper and lower boundaries of the claimed ranges are critical to the invention. Furthermore, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454 456, 105 USPQ 233, 235 (CCPA 1955). Where applicant's range covers such a large portion of the prior art range, it has been held to be obvious to find applicant's claimed ranges through optimization, especially in view of there being ranges of composition wherein the color of the alloy is only present for certain compositions.

With regards to applicant's argument (3), the additions of nickel and palladium in the claimed invention and the prior art are discussed in above paragraph 7.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew E Wessman whose telephone number is (703)305-3163. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703)308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

AEW  
November 6, 2002

*R* (C)  
ROY KING  
SUPERVISORY PATENT EXAMINER  
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